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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,886	06/25/2003	Kieran P. Murphy	331202.00007	2271
27160	7590	12/30/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			THANH, LOAN H	
525 WEST MONROE STREET			ART UNIT	
CHICAGO, IL 60661-3693			PAPER NUMBER	
			3763	
DATE MAILED: 12/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,886

Applicant(s)

MURPHY ET AL.

Examiner

LoAn H. Thanh

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/05 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claims 31-35 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31-35 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The combination of the elements with the functional language is not supported as originally filed or currently claimed. The only support applicant has is in paragraph 36. There a stylet is removed from the Tuohy needle not a guidewire. The guide wire is removed from the catheter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross (USPN 5,002,535).

Gross discloses a spinal catheter having a narrow end and outer surface forming a tapering continuously from the narrow end of the catheter to the seal. See figures 7-8 and column 8 , lines 33-49 and column 6, lines 17. Gross disclose the length of the catheter to be approximately 3.5 inches. See column 4, lines 10-12. It would be inherent that all the embodiments of the Gross as shown in figures 6-8 would be the same size.

Claims 18-19,23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Utterberg et al. (USPAP 2001/003149 A1).

Unterberg et al. discloses a catheter having a narrow end, an outer surface with a continuously taper. See figures 1-1a, 5-6. Utterberg et al. disclose a narrow end that is less than 14 Gauge (11-13 gauge) and the proximal end having a greater than 14 G (14-15 Gauge) and the taper being substantially along its entire length.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-21 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross (USPN 5,002,535) or Utterberg et al. (USPAP 2001/003149 A1) in view of Karakelle et al. (USPN 5,061,254).

Gross or Utterberg et al. disclose the invention as substantially claimed. See Gross or Utterberg et al. above. Gross or Utterberg et al. both teach a needle structure/catheter to be inserted into a patient. However, Gross or Utterberg et al. is silent to an outer surface coating of infection resistant layer or adhesion resistant layer thereon. Karakelle et al. disclose a needle structure/catheter with a coating of anti-infective agents well known in the art to be inserted into a patient. Thus, it would have been obvious to one of ordinary skill in the art to modify needle/catheter structure of Gross or Utterberg et al. with a coating of anti-infective agents as taught by Karakelle et al. in order to avoid further introducing or exposing the patient with microbial or clotting.

Claims 25-30 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross (USPN 5,002,535) in view of Utterberg et al. (USPAP 2001/003149 A1) and further in view of Karakelle et al. (USPN 5,061,254).

Gross discloses the invention as substantially claimed. See Gross above. Gross teaches a needle structure/catheter to be inserted into a patient having a continuous taper from the proximal to the distal end. However, Gross is silent to a 14 gauge size of the needle. Utterberg et al. teach a 14 gauge needle that tapers from the proximal end to the distal end. It would have been obvious to one of ordinary skill in the art to modify the gauge size as claimed as a mere design choice lacking any criticality of size as being merely preferable for the intended target size of the patient where the only

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difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device would not be patentably distinct from the prior art.

With respect to claims 26-27, Gross in view of Utterberg et al. are silent to an outer surface coating of infection resistant layer or adhesion resistant layer thereon. Karakelle et al. disclose a needle structure/catheter with a coating of anti-infective agents well known in the art to be inserted into a patient. Thus, it would have been obvious to one of ordinary skill in the art to modify needle/catheter structure of Gross in view of Utterberg et al. with a coating of anti-infective agents as taught by Karakelle et al. in order to avoid further introducing or exposing the patient with microbial or clotting.

Response to Arguments

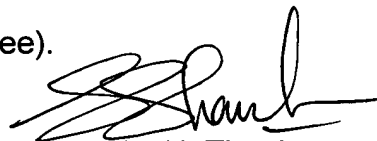
Applicant's arguments filed 10/11/05 have been fully considered but are moot in view of the new rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (571) 272-4966. The examiner can normally be reached on Mon. - Fri. (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'LoAn H. Thanh', with a stylized flourish at the end.

LoAn H. Thanh
Primary Examiner
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LT
12/27/05